IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Eric Moore et al.	Art Unit	: 2192
Patent No.	: 7,565,642	Examiner	: Zheng Wei
Issue Date	: July 21, 2009	Conf. No.	: 6822
Serial No.	: 10/639,674		
Filed	: August 11, 2003		
Title	: RULE ENGINE		

Commissioner for Patents
P.O. Box 1450
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APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 1017 to <u>1616 days</u>, is respectfully requested.

REMARKS

"A Delays" are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. "B Delays" are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in <u>Wyeth et al. v. Jon W. Dudas</u> (580 F. Supp. 2d 138; 88 USPQ 2d 1538), the only way that these periods of time can "overlap" is if they occur on the same day. If an "A delay" occurs on one calendar day and a "B delay" occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. <u>Id.</u>

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The <u>Wyeth v. Dudas</u> court determined that this construction cannot be squared with the language of 35 U.S.C. § 154(b)(1)(B), which applies "if the issue of an original patent is delayed due to the

Applicant : Eric Moore et al.   Attorney's Docket No.: 11973-0007001
Patent No. : 7,565,642
Issued   : July 21, 2009
Serial No. : 10/639,674
Filed   : August 11, 2003
Page   : 2 of 5

failure of the United States Patent and Trademark Office to issue a patent within 3 years."

"B delay" begins only after the PTO has failed to issue a patent within three years, not before.

Id.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

"A Delay"

A first PTO action was due on or before October 11, 2004 (the date that is fourteen months after August 11, 2003, the date on which the application was filed). The PTO mailed the first non-final Office Action on November 13, 2006, thereby according a PTO Delay of 763 days. Patentee does not dispute the PTO's calculation for this "A Delay" from October 12, 2004 (the day after the date that is fourteen months after the date on which application was filed), to November 13, 2006. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

A PTO action was due on or before December 15, 2007 (the date that is four months after August 15, 2007, the date on which a response to Office Action was filed). The PTO mailed a non-final Office Action on April 15, 2008, thereby according a PTO Delay of 122 days. Patentee does not dispute the PTO's calculation for this "A Delay" from December 16, 2007 (the day after the date that is four months after the date on which a response to Office Action was filed), to April 15, 2008. See 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2).

In view of the period of "A Delay" detailed above, the total "A Delay" for this patent should be calculated as 885 days.

"B Delay"

The period beginning on August 12, 2006 (the day after the date that is three years after August 11, 2003, the date on which the application was filed), and ending July 21, 2009 (the date the patent was issued), is 1075 days in length.

"B Delay" may not include the number of days in the period beginning on the date on which a Request for Continued Examination was filed and ending on the date the patent was issued. In the present application, no Request for Continued Examination was filed. See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1).

Applicant : Eric Moore et al.   Attorney's Docket No.: 11973-0007001
Patent No. : 7,565,642
Issued   : July 21, 2009
Serial No. : 10/639,674
Filed   : August 11, 2003
Page   : 3 of 5

In addition, "B Delay" may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a Notice of Allowance. In the present application, a Notice of Appeal was filed on December 14, 2007, and a non-final Office Action was mailed by the PTO on April 15, 2008, resulting in a period of 123 days that must be excluded from the three year delay calculation. See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4).

In view of the periods of "B Delay" detailed above, the total "B Delay" for this patent should be calculated as 952 days (i.e., 1075 days minus 123 days). The PTO calculated 190 days of delay for issuance of a patent more than three years after filing. Patentee respectfully submits that the PTO's calculation of this "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 952 days. See 37 C.F.R. §§ 1.702(b) and 1.703(b).

Overlap of "A Delay" and "B Delay"

As detailed above, "A Delay" accumulated during the following periods:

        October 12, 2004, to November 13, 2006; and

        December 16, 2007, to April 15, 2008.

As detailed above, "B Delay" accumulated during the following periods:

        August 12, 2006, to December 14, 2007; and

        April 16, 2008, to July 21, 2009.

As such, the periods of "A Delay" and "B Delay" overlap (i.e., occur on the same calendar day) for a total of 94 days, from August 12, 2006, to November 13, 2006.

Applicant Delay

A reply to an Office Action was due on or before February 13, 2007 (the date that is three months after November 13, 2006, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on March 12, 2007, thereby according an Applicant Delay of 27 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from February 14, 2007 (the day after the date that is three months after the date on which the Office Action was mailed), to March 12, 2007. See 37 C.F.R. § 1.704(b).

Applicant : Eric Moore et al.   Attorney's Docket No.: 11973-0007001
Patent No. : 7,565,642
Issued   : July 21, 2009
Serial No. : 10/639,674
Filed   : August 11, 2003
Page   : 4 of 5

A reply to an Office Action was due on or before July 15, 2008 (the date that is three months after April 15, 2008, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on August 15, 2008, thereby according an Applicant Delay of 31 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from July 16, 2008 (the day after the date that is three months after the date on which the Office Action was mailed), to August 15, 2008. See 37 C.F.R. § 1.704(b).

Patentee filed an Information Disclosure Statement on October 23, 2008, subsequent to a reply filed on August 15, 2008. No Applicant Delay was accorded for this reply; however, in good faith and candor, Patentee respectfully submits that the Supplemental Information Disclosure Statement should have been accorded a total Applicant Delay of 69 days for delay from August 16, 2008, to October 23, 2008. See 37 C.F.R. § 1.704(c)(8).

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 127 days (i.e., the sum of 27 days, 31 days, and 69 days).

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Conclusion

In consideration of the events described above, Patentee believes the PTA calculation of 1017 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

1)   Total PTO Delay should be calculated as 1743 days (i.e., the sum of 885 days of "A Delay" and 952 days of "B Delay" minus 94 days overlapping delay);

2)   Total Applicant Delay should be calculated as 127 days (i.e., the sum of 27 days, 31 days, and 69 days); and

3)   Total PTA should be calculated as 1616 days.

The required fee under 37 C.F.R. § 1.18(e) in the amount of $200 is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account

Applicant : Eric Moore et al.   Attorney's Docket No.: 11973-0007001
Patent No. : 7,565,642
Issued   : July 21, 2009
Serial No. : 10/639,674
Filed   : August 11, 2003
Page   : 5 of 5

authorization. Please apply any other required charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 11973-0007001.

Respectfully submitted,

Date: September 21, 2009   /Brian J. Gustafson/
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